

JAN 17 2006

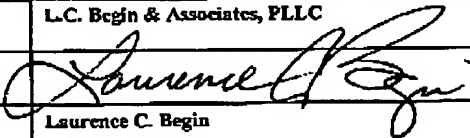
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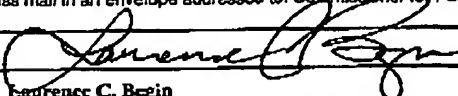
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| TRANSMITTAL FORM | Application Number | 10/047,586 | |
| | Filing Date | October 29, 2001 | |
| | First Named Inventor | Edwin E. Suer | |
| | Art Unit | 3724 | |
| | Examiner Name | Ghassem Alle | |
| (to be used for all correspondence after initial filing) | | | |
| Total Number of Pages in This Submission | 22 | Attorney Docket Number | 5758-01001 |

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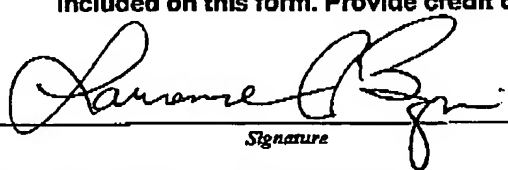
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| Firm Name | L.C. Begin & Associates, PLLC | | |
| Signature |  | | |
| Printed name | Laurence C. Begin | | |
| Date | January 17, 2006 | Reg. No. | 42,310 |

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JAN 17 2006

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| TRANSMITTAL OF APPEAL BRIEF (Small Entity) | | | | | Docket No. 5788-01001 |
| In Re Application Of: Edwin E. Suer | | | | | |
| Application No. 10/047,586 | Filing Date 10/29/01 | Examiner Ghassem Alie | Customer No. 46510 | Group Art Unit 3724 | Confirmation No. 4694 |
| Invention: Hot Dog Slicer | | | | | |
| <p><u>COMMISSIONER FOR PATENTS:</u></p> <p>Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:</p> <p><input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27</p> <p>The fee for filing this Appeal Brief is: \$250.00</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-3238</p> <p><input checked="" type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 20px;"> <div style="text-align: center;">  <i>Signature</i> </div> <div> <p>Dated: January 17, 2006</p> </div> </div> <div style="margin-top: 20px;"> <p>Laurence C. Begin Reg. No. 42,310 L.C. Begin & Associates, PLLC 510 Highland Avenue PMB 403 Milford, Michigan 48381</p> </div> | | | | | |
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IN THE UNITED STATES PATENT
AND TRADEMARK OFFICEGroup Art Unit 3724
Examiner Ghassem Alie

EDWIN E. SUER

APPEAL BRIEF

Serial No. 10/047,586

Filed October 29, 2001

For: HOT DOG SLICER/

January 17, 2006

Box AF
Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This is an appeal from the final rejection of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17 set forth in the office action mailed July 11, 2005.

(1) Real Party of Interest:

The real party of interest in this appeal is the inventor and owner of the present application, Edwin E. Suer.

(2) Related Appeals and Interferences:

There are presently no other appeals and/or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by the Board's decision in the pending appeal.

(3) Status of Claims:

Claims 1-17 are pending. Claims 3, 5, 8, 11, 12, and 15 are withdrawn from consideration. Claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17 are stand finally rejected in an Office Action dated July 11, 2005 (Paper # Mail Date 20050705).

(4) Status of Amendments:

No Amendment was filed After the Final Rejection.

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(5) Summary of the Invention:

A cylindrically-shaped hollow body containing an internal plurality of blades is provided. The food product is inserted into the cylinder and then sliced by linear movement of the blades over at least a portion of the length of the cylinder. Alternatively, the blades may be fixed across the diameter of the cylinder whereby forcing the food or meat product past the blades results in the same cut to the meat. The resulting food product exhibits uniformly sliced portions of the cylindrical food product having approximately equivalent dimensions. Furthermore, the present invention results in an economical and simplified cutting device as compared to other devices described in the art cited.

(6) Issues:

Did the Examiner err by rejecting claims:

- a) – 1, 2, and 4 under 35 U.S.C. 102(b) as being unpatentable over Gagliardi, Jr. (U.S. Patent No. 5,771,771) or '771?
- b) – 1, 2, and 4 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 in view of Pesce (U.S. Patent No. 2,675,317) '317 or in view of Priore (U.S. Patent No. 3,060,838) '838?
- c) – 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 and in further view of Berler (U.S. Patent No. 4,250,771)?
- d) – 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 in view of Pesce or Priore, as applied to claim 1, and in further view of Berler?
- e) – 1, 2, 4, 9, 10, 16, and 17 under 35 U.S.C. 103(a) as being unpatentable by Pesce '317 in view of Gagliardi '771 or Aguerrevere et al. (U.S. Patent No. 5,271,317)?
- f) – 6, 7, 13, and 14 under 35 U.S.C. 103(a) as being unpatentable over Pesce '317 in view of Gagliardi '771 or Aguerrevere and

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in further view of Berler?

g) – 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over
Lin in view of Berler?

(7) Grouping of Claims:

- i) Claims 1 and 4 stand together with respect to an elongated hollow body.
- ii) Claim 2 stands alone with respect to a hollow body.
- iii) Claims 6 and 7 stand together with respect to an elongated body having a food receptacle removably attached to the first end.
- iv) Claims 9 and 10 stand together with respect to an elongated body having a single plurality of blades fixed to the body.
- v) Claims 13 and 14 stand together with respect to an elongated body having a plurality of blades fixed within the interior to prevent movement of the blades.
- vi) Claims 16 and 17 stand together with respect to an elongated body having a fixed plurality of blades to prevent movement of the blades, wherein each of the blades are substantially laterally aligned with the other blades.

(8) Arguments:

a) Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,771,771 to Gagliardi, Jr. ('771). As positively claimed in these claims, given in the Appendix, each of the plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.

Applicant respectfully notes that '771 describes blades 38 that are provided in two or more tiers as described at column 3, line 53 through column 4, line 17, for example. As shown in the figures, and as indicated in column 3,

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lines 53-60, the two or more tiers are oriented at different axial positions along the length of the apparatus 10. Accordingly, because of the two different axial positions, there is simply no lateral alignment of all of the blades at an outermost portion of the blades as required in the present claims. Stated another way, each of the blades 38 are not aligned side by side with another respective blade at an outermost portion thereof. Because the two tiers occupy different longitudinal positions, they can in no way satisfy lateral alignment at outermost portions of the blade.

It should further be emphasized that as affirmatively claimed in claims 1 and 2, the blades of the present cutting device extend across the interior of the body in a plane perpendicular to the inner and outer walls of the body. The blades 38 of Gagliardi '771 do not extend across the interior of the housing 14 in a plane perpendicular to the housing 14. Rather, the blades 38 of the housing 14 of Gagliardi extend partially into the interior of the housing 14, but not across the interior of the housing 14. Applicant would point out that Webster's Dictionary defines "across" as "from one side to the opposite side of". See Webster's New Collegiate Dictionary, Page 11, Copyright 1981, G. & C. Merriam Co. Accordingly, Gagliardi does not describe blades extending "across" the interior of the body.

Further, as described in '771, the blades 38 do not extend in a single plane, but rather might for the sake of argument be said to extend in at least two separate planes perpendicular to the housing 14 (e.g. two tiers of blades 38). See the figures of Gagliardi, and see the column 3, lines 53-67 for example.

Applicant therefore respectfully traverses the rejections of claims 1, 2, and 4 under 35 U.S.C 102(b), for neither Gagliardi ('771), nor any other reference of record describes with particularity the present limitations. Nor does '771 either alone or taken with another reference of record describe, suggest, or otherwise motivate one of ordinary skill in the art to form an article as claimed or to slice a food product as claimed. For none of the references when taken

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alone or in combination describe all of the limitations of the claims, or alternatively, provide motivation to combine the same.

b) Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,771,771 to Gagliardi, Jr. ('771) in view of Pesce (2,675,317) or Priore (3,060,838). As positively claimed in the claims given above, each of the plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades. Gagliardi solves the problem of cutting multiple segments in a hot dog without an undue amount of pressure necessary to cut:

"As shown, when the cutter member 32 is moved from the first position toward the second position, the blades 38 of the first tier 40a contact the hot dog first, while the blades 38 of the second tier 40b are delayed in contacting the hot dog 12 until the first tier 40a has already penetrated the exterior of the hot dog 12. As should be appreciated, such an arrangement is preferable in that the pressure necessary to initiate four cuts simultaneously in the exterior of the hot dog 12 is less than the pressure necessary to initiate eight such cuts simultaneously..." See column 4, lines 1-10 of '771.

Accordingly, even though the examiner indicates that it would be obvious to one having ordinary skill in the art at the time the invention was made to omit or eliminate one of the tier of blades in Gagliardi, this notion or argument is opposite to the purpose of the plurality of tiers of blades of Gagliardi. Stated another way, Gagliardi teaches away from the present invention as evident by the text presented above. When a reference *teaches away* from an invention, it cannot simultaneously suggest or motivate one to practice the same invention. Additionally, a reference must be considered in its entirety when considering its value as a prior art reference. Finally, a reference that teaches away must be disqualified as a prior art reference by virtue of it teaching away from the invention at hand. Stated another way, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir.1983).

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Applicant respectfully notes that '771 describes blades 38 that are provided in two or more tiers as described at column 3, line 53 through column 4, line 17, for example. As shown in the figures, and as indicated in column 3, lines 53-60, the two or more tiers are oriented at different axial positions along the length of the apparatus 10. Accordingly, because of the two different axial positions, there is simply no lateral alignment of all of the blades at an outermost portion of the blades as required in the present claims. Stated another way, each of the blades 38 are not aligned side by side with another respective blade at an outermost portion thereof. Because the two tiers occupy different longitudinal positions, they can in no way satisfy lateral alignment at outermost portions of the blade. Further, because Gagliardi's solution to reducing the pressure to cut the hot dog is to provide two or more tiers of blades, it is simply improper to combine other references that would contradict that purpose or solution to the problem.

Furthermore, Gagliardi does not describe an embodiment having only one plurality of blades *extending across* the interior in a plane perpendicular to the inner and outer walls of the hollow body. Applicant would point out that Webster's Dictionary defines "across" as "from one side to the opposite side of". See Webster's New Collegiate Dictionary, Page 11, Copyright 1981, G. & C. Merriam Co. Accordingly, Gagliardi does not describe blades extending "across" the interior of the body.

For the same reasons indicated in the response to the 102(b) rejection (incorporated herein by reference), Gagliardi does not in and of itself describe or suggest all of the limitations of claims 1, 2, and 4. A prima facie case of obviousness is only supported when all of the limitations of the claims are described by the reference(s) supporting the rejection. Again, Gagliardi describes multiple tiers of blades, not a single plurality of blades laterally aligned at outer points as described and claimed in claims 1, 2, and 4.

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With regard to **Pesce** and **Priore**, Applicant is of the position that in the absence of **Gagliardi** (due to its disqualification as prior art for teaching away from the present invention), **neither Pesca nor Priore** would when taken alone or together satisfy the requirement that the body be "elongated" as per claim 1, or that the body have "a length greater than the cross-sectional area of the body" as per claim 2.

Applicant would point out that *Webster's Dictionary* defines "elongated" as "long in proportion to width". See *Webster's New Collegiate Dictionary*, Page 366, Copyright 1981, G. & C. Merriam Co. Neither **Pesce** nor **Priore** describe an "elongated" body as described in the specification and shown in the figures, or as described by Webster. Furthermore, **Priore** does not describe the cutting of an elongated flexible food product such as a hot dog, but rather a pie. One looking to solve the problem of cutting a hot dog would not look to **Priore** because **Priore** is not concerned with cutting flexible meat products, but is instead concerned with cutting a pie or pastry. A pie or pastry is certainly not an elongated food product where the length is greater in dimension than the width. **Pesce** solves the problem of cutting a flexible food product by employing a cutting apparatus that does not involve an elongated body but instead utilizes a short body having a diameter greater than its width. There is nothing in **Pesce** to suggest changing the body to that shown in **Gagliardi**. Furthermore, feeding the hot dog through the cutter of **Pesce** in the manner described would not be possible if using an elongated body like that of **Gagliardi**. In sum, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Finally, as discussed in column 1, lines 38-40, **Pesce** states that it is an object of the invention to provide a cutter for hot dogs and the like which is of a simple and economical construction. Certainly, providing an elongated housing as claimed in the present invention is counterintuitive with regard to the design

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that Pesce describes. Accordingly, Pesce actually teaches away from providing a construction that is more complex and/or expensive than what he describes. It will be appreciated that the present elongated hollow body requires more raw material and is therefore more expensive and of greater complexity.

Applicant therefore takes the position that the Office has not stated a prima facie case of obviousness. In particular, the references when taken alone or together must with particularity state all of the limitations of the claims. As noted by the examiner, the blades 38 of '771 exist in at least two tiers and are therefore not laterally aligned. Nevertheless, the examiner indicates that it would have been obvious to one of ordinary skill in the art to remove one of the tiers of blades of '771. The examiner, however, has not pointed to the requisite motivation to do the same.

In fact, '771 indicates that two or more tiers reduce the cutting pressure against the food product thereby requiring less force to cut the hot dog. See column 3, line 53 through column 4, line 17 of '771, herein incorporated by reference. Accordingly, '771 teaches away from laterally aligning the blades 38, or stated another way, from eliminating one of the two tiers of blades 38. Elimination of one of the tiers would be counterintuitive to one of ordinary skill given the comments by Gagliardi. Furthermore, without a showing of a motivation, the examiner's argument is apparently a prohibited "obvious to try" rationale that without objective support is not supportive of a prima facie case of obviousness.

Accordingly, Applicant traverses the rejection of the claims under 35 U.S.C. 103(a) over Gagliardi in view of Pesce or Priore, for in view of the arguments presented, a prima facie case of obviousness has not been supported by any of the references taken alone or in combination. Further, when a reference teaches away from an invention, it cannot concurrently suggest the same.

c) Claims 6 and 7 are rejected under 35 U.S.C 103(a) as being unpatentable

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over Gagliardi, and further in view of Berler. As noted above in the 102(b) and 103(a) discussions of Gagliardi, incorporated herein by reference, Gagliardi does not describe a cutting device with a single plurality of blades whereby each blade has an outermost portion substantially laterally aligned with respective outermost portions of the remaining blades. The inherent advantages of such a device includes manufacturing simplification with reduced costs and reduced parts, while still providing a sliced product. With regard to claims 6 and 7, Berler does not resolve the deficiencies of Gagliardi as described above, for neither Berler nor Gagliardi when taken alone or combined describe a plurality of blades laterally aligned at outermost portions of the blades.

d) Claims 6 and 7 are rejected under 35 U.S.C 103(a) as being unpatentable over Gagliardi in view of Pesce or Priore, and further in view of Berler. Applicant directs the examiner's attention to the discussion of item b) relative to Gagliardi, Pesce and Priore, and incorporates the same discussion herein by reference. For the reasons stated above in item b), Applicant takes the position that neither Gagliardi, Pesce, nor Priore when taken alone or together would suggest or motivate one of ordinary skill in the art to provide a cutter as claimed in claims 6 and 7. The inherent advantages of such a device includes manufacturing simplification with reduced costs and reduced parts, while still providing a sliced product. With regard to claims 6 and 7, Berler does not resolve the deficiencies of Gagliardi, Pesce, or Priore as described above, for Berler does not describe a plurality of blades laterally aligned at outermost portions of the blades extending across a body interior in a plane perpendicular to the body. This design provides a device that effectively cuts the meat product while reducing the complexity of the cutting device.

In sum, in view of the reasons given above, there is no motivation found in either reference to combine one with the other. The requisite motivation to combine must be found within the references when asserting a prima facie case

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of obviousness. Further, when a reference teaches away from an invention, it cannot concurrently suggest the same.

e) Claims 1, 2, 4, 6, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pesce in view of Gagliardi or Aguerrevere et al. Applicants take the position that the examiner has not shown the requisite motivation to combine the references. Specifically, Pesce does not provide any suggestion or motivation to provide an elongated housing wherein the length is greater than the diameter. There must be some suggestion or motivation within the reference to show the requisite motivation to combine. The examiner has not with particularity stated the reason or motivation to combine. In essence, Pesce does not recognize the need to provide a support for the hotdog within the apparatus and therefore does not contemplate an elongated body for support of an elongated food body, in accordance with the present invention.

As discussed in column 1, lines 38-40, Pesce states that it is an object of the invention to provide a cutter for hot dogs and the like which is of a simple and economical construction. Certainly, providing an elongated housing as claimed in the present invention is counterintuitive with regard to the design that Pesce describes. Accordingly, Pesce actually teaches away from providing a construction that is more complex and/or expensive than what he describes. It will be appreciated that the present elongated hollow body requires more raw material and is therefore more expensive.

With regard to the combination of Gagliardi with Pesce, Applicant incorporates by reference the argument presented in item b) above. For the reasons given, Gagliardi would not alter the multiple-tier design of the blades in the cutting device described therein, for doing so would be counter to the problem solved by Gagliardi: that is simplifying the cutting of a meat product such as a hot dog. Furthermore, Gagliardi teaches movable blades, not fixed blades. As such, Gagliardi teaches away from claims 1, 2, 4, 6, 9, 10, 16, and 17.

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It should further be emphasized that counter to claims 9, 10, 16, and 17, the blades 14 of Pesce are not fixed to prevent movement and in fact rotate with collar 13. See column 3, lines 1-10, for example. There is nothing to suggest that the blades should be fixed to the housing as in the present invention. Note column 4, lines 23-27 of Pesce, for example, wherein rotation of the blades in the outer casing is assured by an inner edge 48. Accordingly, Pesce teaches away from fixed blades as affirmatively claimed in claims 9, 10, 16, and 17.

Aguerrevere does not resolve the deficiencies of Gagliardi or Pesce. For like Gagliardi, Aguerrevere indicates that two tiers of blades, 23 and 24, respectively, are included in the cutting device. There is no motivation or suggestion offered within the references themselves to change the design to a single tier of blades, as affirmatively claimed in the present invention.

f) Claims 6, 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pesce in view of Gagliardi or Aguerrevere, and in further view of Berler. Applicant takes the position that a prima facie case of obviousness with regard to claims 6 and 7 has not been shown. Regarding claims 6 and 7, Applicant again notes that neither Pesce nor Berler describe a hollow body having a length greater than its diameter (e.g. elongated). Nor, as explained above, is there any suggestion or motivation within Pesce to combine a reference that describes an elongated housing. The comments given above are equally applicable here and are incorporated by reference. In essence, none of the references describes an elongated housing, or a body having a length greater than the diameter. Accordingly, a prima facie case of obviousness has not been supported with regard to claims 6 and 7.

With regard to claims 13 and 14, Applicant takes the position that the current amendments define fixed blades that prevent movement of the blades. Pesce, Gagliardi, and Ageurrerre all describe blades that either rotate within a collar 13, or move along the body of the device. It will further be appreciated

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that again, with regard to the length being greater than the diameter, Pesce does not suggest or motivate one of ordinary skill in the art to change his housing to the elongated body of the present invention. There must be some motivation to combine the references within the references themselves to properly support a prima facie case of obviousness. Stated another way, there is no motivation or suggestion offered within the references themselves to change the design to a single fixed tier of blades, as affirmatively claimed in claims 13 and 14 of the present invention.

g) Claims 13 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Berler. Lin does not describe a cutting device having a plurality of blades extending across the interior (that is from one side to the other) and fixed within the interior of the body. If Lin did describe this, then the coring function described in column 3 of Lin would not be possible. Berler does not cure this deficiency of Lin and therefore a prima facie case of obviousness is not supported.

Finally, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, *and not based on applicant's disclosure*". In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It would appear that the examiner, with the benefit of the present application, exercised impermissible hindsight reconstruction, particularly in view of the art cited. For the particular combination of the elements of the present invention as claimed are not suggested or described in the references cited, for the references describe other cutting problems solved in other ways. None of the references cited by the examiner enable the present approach, nor do they recognize the present problem of supporting a flexible meat product to ensure a steady plurality of cuts throughout the meat product length if desired. As such, they cannot when taken alone or in combination

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with each other of present or suggest a solution to the same when viewed by one of ordinary skill in the art.

Further, "A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The examiner has not provided an objective reason to combine the references other than to suggest that all the references describe cutting devices and therefore all the features should be interchangeable. This would ignore the solutions to the various problems that each reference in and of itself solves in the cutting art.

In sum, none of the references when taken alone or when taken together suggest or describe the present invention. Stated another way, for the reasons given, a prima facie case of obviousness cannot be supported by references that teach away from the present invention, nor can it be supported without the requisite showing of a motivation to combine the references.

The examiner is advised that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) Utilizing the cutting device of Lin would change the cuts provided by the present invention and therefore the principle of operation of the device.

The examiner is further advised that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

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(9) Conclusion:

In sum, Applicant respectfully traverses the rejections given for the reasons stated.

Accordingly, the allowance of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17, and passage of the subject application to issue is courteously solicited.

For the above-stated reasons, the examiner has simply not met the burden of substantiating a prima facie case of obviousness relative to claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17. Accordingly, reversal of the Examiner's rejection of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17, and issuance of the present application is courteously solicited.

Applicants have calculated a fee of \$250.00 for the appeal brief in connection with this brief. Our credit card authorization sheet is enclosed authorizing the amount of \$250.00. The Commissioner is hereby authorized to charge any additional fees incident to the filing of this communication to Deposit Account No. 50-3238. A duplicate copy of the front page of this document is enclosed. Applicants have faxed three copies of this appeal brief pursuant to 37 C.F.R. 1.192.

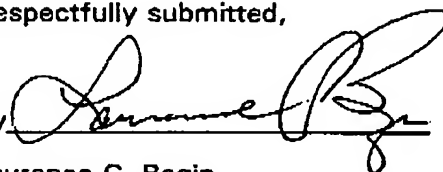
Date

1/17/06

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Respectfully submitted,

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(10) Appendix – Claims 1-17:

1. (pending and previously presented) A food utensil comprising:

an elongated hollow body for supporting an elongated food product, said elongated hollow body having an inner wall and an outer wall forming an interior, an open first end and a second end, a diameter, and a length greater than said diameter; and

a plurality of blades extending across said interior in a plane perpendicular to said inner and outer walls for cutting a food item, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.
2. (pending and previously presented) A food utensil comprising:

a hollow body having an inner wall and an outer wall forming an interior, an open first end and a second end, a cross-sectional area, and a length greater than said cross-sectional area; and

a plurality of blades extending across and said interior in a plane perpendicular to said inner and outer walls for cutting a food item, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.
3. (withdrawn) The utensil of claim 1 further comprising a plurality of grooves each longitudinally extending from the first end to a corresponding

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plurality of points approaching the second end and a blade rack slidably engaged with said outer wall for attachment of said plurality of blades wherein each of said plurality of blades correspondingly extends through one of said plurality of grooves.

4. (pending and previously presented) The utensil of claim 1 further comprising a base fixed to the second end.
5. (withdrawn) The utensil of claim 2 wherein said plurality of blades comprises a plurality of wires wrapped about said blade rack.
6. (original) The utensil of claim 1 further comprising a food receptacle removably attached to said first open end for holding a food product.
7. (original) The utensil of claim 6 further comprising at least one hole extending through said food receptacle and at least one corresponding prong extending through said at least one hole for holding said food product.
8. (withdrawn) The utensil of claim 2 wherein each of said plurality of grooves with respect to another equidistantly terminates between said first and second ends.
9. (pending and previously presented) The utensil of claim 1 wherein said plurality of blades is fixed to said inner wall thereby preventing movement of said plurality of blades.
10. (pending and previously presented) The utensil of claim 1 wherein said plurality of blades is fixed to said open first end thereby preventing movement of said plurality of blades.
11. (withdrawn) A food utensil comprising:

an elongated hollow body for encasing an elongated food product, said elongated hollow body having an inner wall forming an interior and an outer wall, an open first end and a closed second end, a

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diameter, a length greater than said diameter, and, a plurality of grooves each longitudinally extending from the first end to a corresponding plurality of points approaching the second end;

a plurality of blades extending across said interior, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and

a blade rack slidably engaged with said outer wall for attachment of said plurality of blades wherein each of said plurality of blades correspondingly extends through one of said plurality of grooves.

12. (withdrawn) The utensil of claim 11 wherein each of said plurality of grooves with respect to another equidistantly terminates between said first and second ends.

13. (pending and previously presented) An appliance comprising:

an elongated hollow body for supporting an elongated food product, said elongated hollow body having an inner wall and an outer wall forming an interior, a diameter, and a length greater than said diameter;

a plurality of blades fixed within said interior and extending across said interior thereby preventing movement of said plurality of blades; and

a receptacle for holding an item to be sliced, that upon appliance operation is slidably engaged along said outer wall thereby forcing said item against said blades for slicing thereof.

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14. (pending and previously presented) A method of slicing a food item comprising:
- providing a fixed plurality of blades within an elongated hollow body and across a diameter thereof thereby preventing movement of said plurality of blades, the elongated hollow body having a length greater than the diameter;
 - inserting an elongated food item to be sliced in a receptacle, said elongated food item supported by said elongated hollow body; and
 - slidably engaging the receptacle along an outer circumference of the hollow body to bias the item against and at least partially through the blades thereby slicing the item.
15. (withdrawn) A method of slicing a food item comprising:
- placing an elongated food item within an elongated hollow body of an appliance along a length of the hollow body, said elongated food item supported by said elongated hollow body, the elongated body having a length greater than a respective diameter;
 - providing a plurality of blades within the hollow body and across the diameter thereof, whereby said plurality of blades is the only plurality of blades of said appliance, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
 - sliding the blades along the length of the hollow body thereby slicing at least a portion of the cylindrical food item.
16. (previously presented) A method of slicing an elongated food item comprising:
- providing a plurality of fixed blades within an elongated hollow body and across a cross-section thereof thereby preventing movement of the blades, the elongated body having a length greater than the

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diameter, whereby said plurality of blades is the only plurality of blades of said elongated food body, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
affecting a relative motion between the elongated food item and the plurality of blades thereby slicing at least a portion of the food item and yet supporting the elongated food item within the elongated hollow body.

17. (previously presented) A food slicer comprising:
an elongated hollow body for slicing an elongated food item, said elongated hollow body having an inner wall and an outer wall, said walls defining an elongated interior that supports the elongated food item, and said hollow body having a length greater than a respective diameter;
a plurality of blades fixed within said elongated hollow body and extending across a cross-section thereof thereby preventing movement of said blades, whereby said plurality of blades is the only plurality of blades of said food slicer, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
a means for affecting a relative motion between said plurality of blades and the elongated food item whereby at least a portion of the elongated food item is sliced within said interior.

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Group Art Unit 3724
Examiner Ghassem Alle

EDWIN E. SUER

APPEAL BRIEF

Serial No. 10/047,586

Filed October 29, 2001

For: HOT DOG SLICER/

January 17, 2006

Box AF
Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This is an appeal from the final rejection of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17 set forth in the office action mailed July 11, 2005.

(1) Real Party of Interest:

The real party of interest in this appeal is the inventor and owner of the present application, Edwin E. Suer.

(2) Related Appeals and Interferences:

There are presently no other appeals and/or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by the Board's decision in the pending appeal.

(3) Status of Claims:

Claims 1-17 are pending. Claims 3, 5, 8, 11, 12, and 15 are withdrawn from consideration. Claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17 are stand finally rejected in an Office Action dated July 11, 2005 (Paper # Mail Date 20050705).

(4) Status of Amendments:

No Amendment was filed After the Final Rejection.

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(5) Summary of the Invention:

A cylindrically-shaped hollow body containing an internal plurality of blades is provided. The food product is inserted into the cylinder and then sliced by linear movement of the blades over at least a portion of the length of the cylinder. Alternatively, the blades may be fixed across the diameter of the cylinder whereby forcing the food or meat product past the blades results in the same cut to the meat. The resulting food product exhibits uniformly sliced portions of the cylindrical food product having approximately equivalent dimensions. Furthermore, the present invention results in an economical and simplified cutting device as compared to other devices described in the art cited.

(6) Issues:

Did the Examiner err by rejecting claims:

- a) - 1, 2, and 4 under 35 U.S.C. 102(b) as being unpatentable over Gagliardi, Jr. (U.S. Patent No. 5,771,771) or '771?
- b) - 1, 2, and 4 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 in view of Pesce (U.S. Patent No. 2,675,317) '317 or in view of Priore (U.S. Patent No. 3,060,838) '838?
- c) - 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 and in further view of Berler (U.S. Patent No. 4,250,771)?
- d) - 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 in view of Pesce or Priore, as applied to claim 1, and in further view of Berler?
- e) - 1, 2, 4, 9, 10, 16, and 17 under 35 U.S.C. 103(a) as being unpatentable by Pesce '317 in view of Gagliardi '771 or Aguerrevere et al. (U.S. Patent No. 5,271,317)?
- f) - 6, 7, 13, and 14 under 35 U.S.C. 103(a) as being unpatentable over Pesce '317 in view of Gagliardi '771 or Aguerrevere and

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in further view of Berler?

g) - 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over
Lin in view of Berler?

(7) Grouping of Claims:

- i) Claims 1 and 4 stand together with respect to an elongated hollow body.
- ii) Claim 2 stands alone with respect to a hollow body.
- iii) Claims 6 and 7 stand together with respect to an elongated body having a food receptacle removably attached to the first end.
- iv) Claims 9 and 10 stand together with respect to an elongated body having a single plurality of blades fixed to the body.
- v) Claims 13 and 14 stand together with respect to an elongated body having a plurality of blades fixed within the interior to prevent movement of the blades.
- vi) Claims 16 and 17 stand together with respect to an elongated body having a fixed plurality of blades to prevent movement of the blades, wherein each of the blades are substantially laterally aligned with the other blades.

(8) Arguments:

a) Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,771,771 to Gagliardi, Jr. ('771). As positively claimed in these claims, given in the Appendix, each of the plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.

Applicant respectfully notes that '771 describes blades 38 that are provided in two or more tiers as described at column 3, line 53 through column 4, line 17, for example. As shown in the figures, and as indicated in column 3,

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lines 53-60, the two or more tiers are oriented at different axial positions along the length of the apparatus 10. Accordingly, because of the two different axial positions, there is simply no lateral alignment of all of the blades at an outermost portion of the blades as required in the present claims. Stated another way, each of the blades 38 are not aligned side by side with another respective blade at an outermost portion thereof. Because the two tiers occupy different longitudinal positions, they can in no way satisfy lateral alignment at outermost portions of the blade.

It should further be emphasized that as affirmatively claimed in claims 1 and 2, the blades of the present cutting device extend across the interior of the body in a plane perpendicular to the inner and outer walls of the body. The blades 38 of Gagliardi '771 do not extend across the interior of the housing 14 in a plane perpendicular to the housing 14. Rather, the blades 38 of the housing 14 of Gagliardi extend partially into the interior of the housing 14, but not across the interior of the housing 14. Applicant would point out that Webster's Dictionary defines "across" as "from one side to the opposite side of". See Webster's New Collegiate Dictionary, Page 11, Copyright 1981, G. & C. Merriam Co. Accordingly, Gagliardi does not describe blades extending "across" the interior of the body.

Further, as described in '771, the blades 38 do not extend in a single plane, but rather might for the sake of argument be said to extend in at least two separate planes perpendicular to the housing 14 (e.g. two tiers of blades 38). See the figures of Gagliardi, and see the column 3, lines 53-67 for example.

Applicant therefore respectfully traverses the rejections of claims 1, 2, and 4 under 35 U.S.C 102(b), for neither Gagliardi ('771), nor any other reference of record describes with particularity the present limitations. Nor does '771 either alone or taken with another reference of record describe, suggest, or otherwise motivate one of ordinary skill in the art to form an article as claimed or to slice a food product as claimed. For none of the references when taken

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alone or in combination describe all of the limitations of the claims, or alternatively, provide motivation to combine the same.

b) Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,771,771 to Gagliardi, Jr. ('771) in view of Pesce (2,675,317) or Priore (3,060,838). As positively claimed in the claims given above, each of the plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades. Gagliardi solves the problem of cutting multiple segments in a hot dog without an undue amount of pressure necessary to cut:

"As shown, when the cutter member 32 is moved from the first position toward the second position, the blades 38 of the first tier 40a contact the hot dog first, while the blades 38 of the second tier 40b are delayed in contacting the hot dog 12 until the first tier 40a has already penetrated the exterior of the hot dog 12. As should be appreciated, such an arrangement is preferable in that the pressure necessary to initiate four cuts simultaneously in the exterior of the hot dog 12 is less than the pressure necessary to initiate eight such cuts simultaneously..." See column 4, lines 1-10 of '771.

Accordingly, even though the examiner indicates that it would be obvious to one having ordinary skill in the art at the time the invention was made to omit or eliminate one of the tier of blades in Gagliardi, this notion or argument is opposite to the purpose of the plurality of tiers of blades of Gagliardi. Stated another way, Gagliardi teaches away from the present invention as evident by the text presented above. When a reference *teaches away* from an invention, it cannot simultaneously suggest or motivate one to practice the same invention. Additionally, a reference must be considered in its entirety when considering its value as a prior art reference. Finally, a reference that teaches away must be disqualified as a prior art reference by virtue of it teaching away from the invention at hand. Stated another way, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir.1983).

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Applicant respectfully notes that '771 describes blades 38 that are provided in two or more tiers as described at column 3, line 53 through column 4, line 17, for example. As shown in the figures, and as indicated in column 3, lines 53-60, the two or more tiers are oriented at different axial positions along the length of the apparatus 10. Accordingly, because of the two different axial positions, there is simply no lateral alignment of all of the blades at an outermost portion of the blades as required in the present claims. Stated another way, each of the blades 38 are not aligned side by side with another respective blade at an outermost portion thereof. Because the two tiers occupy different longitudinal positions, they can in no way satisfy lateral alignment at outermost portions of the blade. Further, because Gagliardi's solution to reducing the pressure to cut the hot dog is to provide two or more tiers of blades, it is simply improper to combine other references that would contradict that purpose or solution to the problem.

Furthermore, Gagliardi does not describe an embodiment having only one plurality of blades *extending across* the interior in a plane perpendicular to the inner and outer walls of the hollow body. Applicant would point out that Webster's Dictionary defines "across" as "from one side to the opposite side of". See Webster's New Collegiate Dictionary, Page 11, Copyright 1981, G. & C. Merriam Co. Accordingly, Gagliardi does not describe blades extending "across" the interior of the body.

For the same reasons indicated in the response to the 102(b) rejection (incorporated herein by reference), Gagliardi does not in and of itself describe or suggest all of the limitations of claims 1, 2, and 4. A prima facie case of obviousness is only supported when all of the limitations of the claims are described by the reference(s) supporting the rejection. Again, Gagliardi describes multiple tiers of blades, not a single plurality of blades laterally aligned at outer points as described and claimed in claims 1, 2, and 4.

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With regard to *Pesce* and *Priore*, Applicant is of the position that in the absence of *Gagliardi* (due to its disqualification as prior art for teaching away from the present invention), neither *Pesce* nor *Priore* would when taken alone or together satisfy the requirement that the body be "elongated" as per claim 1, or that the body have "a length greater than the cross-sectional area of the body" as per claim 2.

Applicant would point out that *Webster's Dictionary* defines "elongated" as "long in proportion to width". See *Webster's New Collegiate Dictionary*, Page 366, Copyright 1981, G. & C. Merriam Co. Neither *Pesce* nor *Priore* describe an "elongated" body as described in the specification and shown in the figures, or as described by Webster. Furthermore, *Priore* does not describe the cutting of an elongated flexible food product such as a hot dog, but rather a pie. One looking to solve the problem of cutting a hot dog would not look to *Priore* because *Priore* is not concerned with cutting flexible meat products, but is instead concerned with cutting a pie or pastry. A pie or pastry is certainly not an elongated food product where the length is greater in dimension than the width. *Pesce* solves the problem of cutting a flexible food product by employing a cutting apparatus that does not involve an elongated body but instead utilizes a short body having a diameter greater than its width. There is nothing in *Pesce* to suggest changing the body to that shown in *Gagliardi*. Furthermore, feeding the hot dog through the cutter of *Pesce* in the manner described would not be possible if using an elongated body like that of *Gagliardi*. In sum, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Finally, as discussed in column 1, lines 38-40, *Pesce* states that it is an object of the invention to provide a cutter for hot dogs and the like which is of a simple and economical construction. Certainly, providing an elongated housing as claimed in the present invention is counterintuitive with regard to the design

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that Pesce describes. Accordingly, Pesce actually teaches away from providing a construction that is more complex and/or expensive than what he describes. It will be appreciated that the present elongated hollow body requires more raw material and is therefore more expensive and of greater complexity.

Applicant therefore takes the position that the Office has not stated a prima facie case of obviousness. In particular, the references when taken alone or together must with particularity state all of the limitations of the claims. As noted by the examiner, the blades 38 of '771 exist in at least two tiers and are therefore not laterally aligned. Nevertheless, the examiner indicates that it would have been obvious to one of ordinary skill in the art to remove one of the tiers of blades of '771. The examiner, however, has not pointed to the requisite motivation to do the same.

In fact, '771 indicates that two or more tiers reduce the cutting pressure against the food product thereby requiring less force to cut the hot dog. See column 3, line 53 through column 4, line 17 of '771, herein incorporated by reference. Accordingly, '771 teaches away from laterally aligning the blades 38, or stated another way, from eliminating one of the two tiers of blades 38. Elimination of one of the tiers would be counterintuitive to one of ordinary skill given the comments by Gagliardi. Furthermore, without a showing of a motivation, the examiner's argument is apparently a prohibited "obvious to try" rationale that without objective support is not supportive of a prima facie case of obviousness.

Accordingly, Applicant traverses the rejection of the claims under 35 U.S.C. 103(a) over Gagliardi in view of Pesce or Priore, for in view of the arguments presented, a prima facie case of obviousness has not been supported by any of the references taken alone or in combination. Further, when a reference teaches away from an invention, it cannot concurrently suggest the same.

c) Claims 6 and 7 are rejected under 35 U.S.C 103(a) as being unpatentable

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over Gagliardi, and further in view of Berler. As noted above in the 102(b) and 103(a) discussions of Gagliardi, incorporated herein by reference, Gagliardi does not describe a cutting device with a single plurality of blades whereby each blade has an outermost portion substantially laterally aligned with respective outermost portions of the remaining blades. The inherent advantages of such a device includes manufacturing simplification with reduced costs and reduced parts, while still providing a sliced product. With regard to claims 6 and 7, Berler does not resolve the deficiencies of Gagliardi as described above, for neither Berler nor Gagliardi when taken alone or combined describe a plurality of blades laterally aligned at outermost portions of the blades.

d) Claims 6 and 7 are rejected under 35 U.S.C 103(a) as being unpatentable over Gagliardi in view of Pesce or Priore, and further in view of Berler. Applicant directs the examiner's attention to the discussion of item b) relative to Gagliardi, Pesce and Priore, and incorporates the same discussion herein by reference. For the reasons stated above in item b), Applicant takes the position that neither Gagliardi, Pesce, nor Priore when taken alone or together would suggest or motivate one of ordinary skill in the art to provide a cutter as claimed in claims 6 and 7. The inherent advantages of such a device includes manufacturing simplification with reduced costs and reduced parts, while still providing a sliced product. With regard to claims 6 and 7, Berler does not resolve the deficiencies of Gagliardi, Pesce, or Priore as described above, for Berler does not describe a plurality of blades laterally aligned at outermost portions of the blades extending across a body interior in a plane perpendicular to the body. This design provides a device that effectively cuts the meat product while reducing the complexity of the cutting device.

In sum, in view of the reasons given above, there is no motivation found in either reference to combine one with the other. The requisite motivation to combine must be found within the references when asserting a prima facie case

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of obviousness. Further, when a reference teaches away from an invention, it cannot concurrently suggest the same.

e) Claims 1, 2, 4, 6, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pesce in view of Gagliardi or Aguerrevere et al. Applicants take the position that the examiner has not shown the requisite motivation to combine the references. Specifically, Pesce does not provide any suggestion or motivation to provide an elongated housing wherein the length is greater than the diameter. There must be some suggestion or motivation within the reference to show the requisite motivation to combine. The examiner has not with particularity stated the reason or motivation to combine. In essence, Pesce does not recognize the need to provide a support for the hotdog within the apparatus and therefore does not contemplate an elongated body for support of an elongated food body, in accordance with the present invention.

As discussed in column 1, lines 38-40, Pesce states that it is an object of the invention to provide a cutter for hot dogs and the like which is of a simple and economical construction. Certainly, providing an elongated housing as claimed in the present invention is counterintuitive with regard to the design that Pesce describes. Accordingly, Pesce actually teaches away from providing a construction that is more complex and/or expensive than what he describes. It will be appreciated that the present elongated hollow body requires more raw material and is therefore more expensive.

With regard to the combination of Gagliardi with Pesce, Applicant incorporates by reference the argument presented in item b) above. For the reasons given, Gagliardi would not alter the multiple-tier design of the blades in the cutting device described therein, for doing so would be counter to the problem solved by Gagliardi: that is simplifying the cutting of a meat product such as a hot dog. Furthermore, Gagliardi teaches movable blades, not fixed blades. As such, Gagliardi teaches away from claims 1, 2, 4, 6, 9, 10, 16, and 17.

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It should further be emphasized that counter to claims 9, 10, 16, and 17, the blades 14 of Pesce are not fixed to prevent movement and in fact rotate with collar 13. See column 3, lines 1-10, for example. There is nothing to suggest that the blades should be fixed to the housing as in the present invention. Note column 4, lines 23-27 of Pesce, for example, wherein rotation of the blades in the outer casing is assured by an inner edge 48. Accordingly, Pesce teaches away from fixed blades as affirmatively claimed in claims 9, 10, 16, and 17.

Aguerrevere does not resolve the deficiencies of Gagliardi or Pesce. For like Gagliardi, Aguerrevere indicates that two tiers of blades, 23 and 24, respectively, are included in the cutting device. There is no motivation or suggestion offered within the references themselves to change the design to a single tier of blades, as affirmatively claimed in the present invention.

f) Claims 6, 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pesce in view of Gagliardi or Aguerrevere, and in further view of Berler. Applicant takes the position that a prima facie case of obviousness with regard to claims 6 and 7 has not been shown. Regarding claims 6 and 7, Applicant again notes that neither Pesce nor Berler describe a hollow body having a length greater than its diameter (e.g. elongated). Nor, as explained above, is there any suggestion or motivation within Pesce to combine a reference that describes an elongated housing. The comments given above are equally applicable here and are incorporated by reference. In essence, none of the references describes an elongated housing, or a body having a length greater than the diameter. Accordingly, a prima facie case of obviousness has not been supported with regard to claims 6 and 7.

With regard to claims 13 and 14, Applicant takes the position that the current amendments define fixed blades that prevent movement of the blades. Pesce, Gagliardi, and Aguerrevere all describe blades that either rotate within a collar 13, or move along the body of the device. It will further be appreciated

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that again, with regard to the length being greater than the diameter, Pesce does not suggest or motivate one of ordinary skill in the art to change his housing to the elongated body of the present invention. There must be some motivation to combine the references within the references themselves to properly support a prima facie case of obviousness. Stated another way, there is no motivation or suggestion offered within the references themselves to change the design to a single fixed tier of blades, as affirmatively claimed in claims 13 and 14 of the present invention.

g) Claims 13 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Berler. Lin does not describe a cutting device having a plurality of blades extending across the interior (that is from one side to the other) and fixed within the interior of the body. If Lin did describe this, then the coring function described in column 3 of Lin would not be possible. Berler does not cure this deficiency of Lin and therefore a prima facie case of obviousness is not supported.

Finally, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, *and not based on applicant's disclosure*". In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It would appear that the examiner, with the benefit of the present application, exercised impermissible hindsight reconstruction, particularly in view of the art cited. For the particular combination of the elements of the present invention as claimed are not suggested or described in the references cited, for the references describe other cutting problems solved in other ways. None of the references cited by the examiner enable the present approach, nor do they recognize the present problem of supporting a flexible meat product to ensure a steady plurality of cuts throughout the meat product length if desired. As such, they cannot when taken alone or in combination

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with each other of present or suggest a solution to the same when viewed by one of ordinary skill in the art.

Further, "A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The examiner has not provided an objective reason to combine the references other than to suggest that all the references describe cutting devices and therefore all the features should be interchangeable. This would ignore the solutions to the various problems that each reference in and of itself solves in the cutting art.

In sum, none of the references when taken alone or when taken together suggest or describe the present invention. Stated another way, for the reasons given, a prima facie case of obviousness cannot be supported by references that teach away from the present invention, nor can it be supported without the requisite showing of a motivation to combine the references.

The examiner is advised that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) Utilizing the cutting device of Lin would change the cuts provided by the present invention and therefore the principle of operation of the device.

The examiner is further advised that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

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(9) Conclusion:

In sum, Applicant respectfully traverses the rejections given for the reasons stated.

Accordingly, the allowance of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17, and passage of the subject application to issue is courteously solicited.

For the above-stated reasons, the examiner has simply not met the burden of substantiating a prima facie case of obviousness relative to claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17. Accordingly, reversal of the Examiner's rejection of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17, and issuance of the present application is courteously solicited.

Applicants have calculated a fee of \$250.00 for the appeal brief in connection with this brief. Our credit card authorization sheet is enclosed authorizing the amount of \$250.00. The Commissioner is hereby authorized to charge any additional fees incident to the filing of this communication to Deposit Account No. 50-3238. A duplicate copy of the front page of this document is enclosed. Applicants have faxed three copies of this appeal brief pursuant to 37 C.F.R. 1.192.

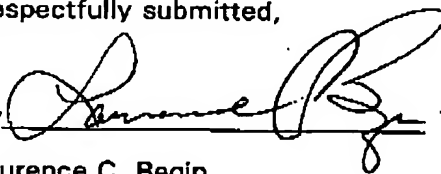
Date

1/17/06

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(10) Appendix – Claims 1-17:

1. (pending and previously presented) A food utensil comprising:

an elongated hollow body for supporting an elongated food product, said elongated hollow body having an inner wall and an outer wall forming an interior, an open first end and a second end, a diameter, and a length greater than said diameter; and

a plurality of blades extending across said interior in a plane perpendicular to said inner and outer walls for cutting a food item, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.
2. (pending and previously presented) A food utensil comprising:

a hollow body having an inner wall and an outer wall forming an interior, an open first end and a second end, a cross-sectional area, and a length greater than said cross-sectional area; and

a plurality of blades extending across said interior in a plane perpendicular to said inner and outer walls for cutting a food item, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.
3. (withdrawn) The utensil of claim 1 further comprising a plurality of grooves each longitudinally extending from the first end to a corresponding

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plurality of points approaching the second end and a blade rack slidably engaged with said outer wall for attachment of said plurality of blades wherein each of said plurality of blades correspondingly extends through one of said plurality of grooves.

4. (pending and previously presented) The utensil of claim 1 further comprising a base fixed to the second end.
5. (withdrawn) The utensil of claim 2 wherein said plurality of blades comprises a plurality of wires wrapped about said blade rack.
6. (original) The utensil of claim 1 further comprising a food receptacle removably attached to said first open end for holding a food product.
7. (original) The utensil of claim 6 further comprising at least one hole extending through said food receptacle and at least one corresponding prong extending through said at least one hole for holding said food product.
8. (withdrawn) The utensil of claim 2 wherein each of said plurality of grooves with respect to another equidistantly terminates between said first and second ends.
9. (pending and previously presented) The utensil of claim 1 wherein said plurality of blades is fixed to said inner wall thereby preventing movement of said plurality of blades.
10. (pending and previously presented) The utensil of claim 1 wherein said plurality of blades is fixed to said open first end thereby preventing movement of said plurality of blades.
11. (withdrawn) A food utensil comprising:

an elongated hollow body for encasing an elongated food product, said elongated hollow body having an inner wall forming an interior and an outer wall, an open first end and a closed second end, a

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diameter, a length greater than said diameter, and, a plurality of grooves each longitudinally extending from the first end to a corresponding plurality of points approaching the second end;

a plurality of blades extending across said interior, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and

a blade rack slidably engaged with said outer wall for attachment of said plurality of blades wherein each of said plurality of blades correspondingly extends through one of said plurality of grooves.

12. (withdrawn) The utensil of claim 11 wherein each of said plurality of grooves with respect to another equidistantly terminates between said first and second ends.

13. (pending and previously presented) An appliance comprising:

an elongated hollow body for supporting an elongated food product, said elongated hollow body having an inner wall and an outer wall forming an interior, a diameter, and a length greater than said diameter;

a plurality of blades fixed within said interior and extending across said interior thereby preventing movement of said plurality of blades; and

a receptacle for holding an item to be sliced, that upon appliance operation is slidably engaged along said outer wall thereby forcing said item against said blades for slicing thereof.

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14. (pending and previously presented) A method of slicing a food item comprising:
- providing a fixed plurality of blades within an elongated hollow body and across a diameter thereof thereby preventing movement of said plurality of blades, the elongated hollow body having a length greater than the diameter;
 - inserting an elongated food item to be sliced in a receptacle, said elongated food item supported by said elongated hollow body; and
 - slidably engaging the receptacle along an outer circumference of the hollow body to bias the item against and at least partially through the blades thereby slicing the item.
15. (withdrawn) A method of slicing a food item comprising:
- placing an elongated food item within an elongated hollow body of an appliance along a length of the hollow body, said elongated food item supported by said elongated hollow body, the elongated body having a length greater than a respective diameter;
 - providing a plurality of blades within the hollow body and across the diameter thereof, whereby said plurality of blades is the only plurality of blades of said appliance, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
 - sliding the blades along the length of the hollow body thereby slicing at least a portion of the cylindrical food item.
16. (previously presented) A method of slicing an elongated food item comprising:
- providing a plurality of fixed blades within an elongated hollow body and across a cross-section thereof thereby preventing movement of the blades, the elongated body having a length greater than the

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diameter, whereby said plurality of blades is the only plurality of blades of said elongated food body, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
affecting a relative motion between the elongated food item and the plurality of blades thereby slicing at least a portion of the food item and yet supporting the elongated food item within the elongated hollow body.

17. (previously presented) A food slicer comprising:
an elongated hollow body for slicing an elongated food item, said elongated hollow body having an inner wall and an outer wall, said walls defining an elongated interior that supports the elongated food item, and said hollow body having a length greater than a respective diameter;
a plurality of blades fixed within said elongated hollow body and extending across a cross-section thereof thereby preventing movement of said blades, whereby said plurality of blades is the only plurality of blades of said food slicer, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
a means for affecting a relative motion between said plurality of blades and the elongated food item whereby at least a portion of the elongated food item is sliced within said interior.

IN THE UNITED STATES PATENT
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Group Art Unit 3724
Examiner Ghassem Alie

EDWIN E. SUER

APPEAL BRIEF

Serial No. 10/047,586

Filed October 29, 2001

For: HOT DOG SLICER/

January 17, 2006

Box AF
Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This is an appeal from the final rejection of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17 set forth in the office action mailed July 11, 2005.

(1) Real Party of Interest:

The real party of interest in this appeal is the inventor and owner of the present application, Edwin E. Suer.

(2) Related Appeals and Interferences:

There are presently no other appeals and/or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by the Board's decision in the pending appeal.

(3) Status of Claims:

Claims 1-17 are pending. Claims 3, 5, 8, 11, 12, and 15 are withdrawn from consideration. Claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17 are stand finally rejected in an Office Action dated July 11, 2005 (Paper # Mail Date 20050705).

(4) Status of Amendments:

No Amendment was filed After the Final Rejection.

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(5) Summary of the Invention:

A cylindrically-shaped hollow body containing an internal plurality of blades is provided. The food product is inserted into the cylinder and then sliced by linear movement of the blades over at least a portion of the length of the cylinder. Alternatively, the blades may be fixed across the diameter of the cylinder whereby forcing the food or meat product past the blades results in the same cut to the meat. The resulting food product exhibits uniformly sliced portions of the cylindrical food product having approximately equivalent dimensions. Furthermore, the present invention results in an economical and simplified cutting device as compared to other devices described in the art cited.

(6) Issues:

Did the Examiner err by rejecting claims:

- a) – 1, 2, and 4 under 35 U.S.C. 102(b) as being unpatentable over Gagliardi, Jr. (U.S. Patent No. 5,771,771) or '771?
- b) – 1, 2, and 4 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 in view of Pesce (U.S. Patent No. 2,675,317) '317 or in view of Priore (U.S. Patent No. 3,060,838) '838?
- c) – 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 and in further view of Berler (U.S. Patent No. 4,250,771)?
- d) – 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Gagliardi, Jr. '771 in view of Pesce or Priore, as applied to claim 1, and in further view of Berler?
- e) – 1, 2, 4, 9, 10, 16, and 17 under 35 U.S.C. 103(a) as being unpatentable by Pesce '317 in view of Gagliardi '771 or Aguerrevere et al. (U.S. Patent No. 5,271,317)?
- f) – 6, 7, 13, and 14 under 35 U.S.C. 103(a) as being unpatentable over Pesce '317 in view of Gagliardi '771 or Aguerrevere and

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in further view of Berler?
g) - 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over
Lin in view of Berler?

(7) Grouping of Claims:

- i) Claims 1 and 4 stand together with respect to an elongated hollow body.
- ii) Claim 2 stands alone with respect to a hollow body.
- iii) Claims 6 and 7 stand together with respect to an elongated body having a food receptacle removably attached to the first end.
- iv) Claims 9 and 10 stand together with respect to an elongated body having a single plurality of blades fixed to the body.
- v) Claims 13 and 14 stand together with respect to an elongated body having a plurality of blades fixed within the interior to prevent movement of the blades.
- vi) Claims 16 and 17 stand together with respect to an elongated body having a fixed plurality of blades to prevent movement of the blades, wherein each of the blades are substantially laterally aligned with the other blades.

(8) Arguments:

a) Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,771,771 to Gagliardi, Jr. ('771). As positively claimed in these claims, given in the Appendix, each of the plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.

Applicant respectfully notes that '771 describes blades 38 that are provided in two or more tiers as described at column 3, line 53 through column 4, line 17, for example. As shown in the figures, and as indicated in column 3,

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lines 53-60, the two or more tiers are oriented at different axial positions along the length of the apparatus 10. Accordingly, because of the two different axial positions, there is simply no lateral alignment of all of the blades at an outermost portion of the blades as required in the present claims. Stated another way, each of the blades 38 are not aligned side by side with another respective blade at an outermost portion thereof. Because the two tiers occupy different longitudinal positions, they can in no way satisfy lateral alignment at outermost portions of the blade.

It should further be emphasized that as affirmatively claimed in claims 1 and 2, the blades of the present cutting device extend across the interior of the body in a plane perpendicular to the inner and outer walls of the body. The blades 38 of Gagliardi '771 do not extend across the interior of the housing 14 in a plane perpendicular to the housing 14. Rather, the blades 38 of the housing 14 of Gagliardi extend partially into the interior of the housing 14, but not across the interior of the housing 14. Applicant would point out that Webster's Dictionary defines "across" as "from one side to the opposite side of". See Webster's New Collegiate Dictionary, Page 11, Copyright 1981, G. & C. Merriam Co. Accordingly, Gagliardi does not describe blades extending "across" the interior of the body.

Further, as described in '771, the blades 38 do not extend in a single plane, but rather might for the sake of argument be said to extend in at least two separate planes perpendicular to the housing 14 (e.g. two tiers of blades 38). See the figures of Gagliardi, and see the column 3, lines 53-67 for example.

Applicant therefore respectfully traverses the rejections of claims 1, 2, and 4 under 35 U.S.C 102(b), for neither Gagliardi ('771), nor any other reference of record describes with particularity the present limitations. Nor does '771 either alone or taken with another reference of record describe, suggest, or otherwise motivate one of ordinary skill in the art to form an article as claimed or to slice a food product as claimed. For none of the references when taken

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alone or in combination describe all of the limitations of the claims, or alternatively, provide motivation to combine the same.

b) Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,771,771 to Gagliardi, Jr. ('771) in view of Pesce (2,675,317) or Priore (3,060,838). As positively claimed in the claims given above, each of the plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades. Gagliardi solves the problem of cutting multiple segments in a hot dog without an undue amount of pressure necessary to cut:

"As shown, when the cutter member 32 is moved from the first position toward the second position, the blades 38 of the first tier 40a contact the hot dog first, while the blades 38 of the second tier 40b are delayed in contacting the hot dog 12 until the first tier 40a has already penetrated the exterior of the hot dog 12. As should be appreciated, such an arrangement is preferable in that the pressure necessary to initiate four cuts simultaneously in the exterior of the hot dog 12 is less than the pressure necessary to initiate eight such cuts simultaneously..."
See column 4, lines 1-10 of '771.

Accordingly, even though the examiner indicates that it would be obvious to one having ordinary skill in the art at the time the invention was made to omit or eliminate one of the tier of blades in Gagliardi, this notion or argument is opposite to the purpose of the plurality of tiers of blades of Gagliardi. Stated another way, Gagliardi teaches away from the present invention as evident by the text presented above. When a reference *teaches away* from an invention, it cannot simultaneously suggest or motivate one to practice the same invention. Additionally, a reference must be considered in its entirety when considering its value as a prior art reference. Finally, a reference that teaches away must be disqualified as a prior art reference by virtue of it teaching away from the invention at hand. Stated another way, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir.1983).

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Applicant respectfully notes that '771 describes blades 38 that are provided in two or more tiers as described at column 3, line 53 through column 4, line 17, for example. As shown in the figures, and as indicated in column 3, lines 53-60, the two or more tiers are oriented at different axial positions along the length of the apparatus 10. Accordingly, because of the two different axial positions, there is simply no lateral alignment of all of the blades at an outermost portion of the blades as required in the present claims. Stated another way, each of the blades 38 are not aligned side by side with another respective blade at an outermost portion thereof. Because the two tiers occupy different longitudinal positions, they can in no way satisfy lateral alignment at outermost portions of the blade. Further, because Gagliardi's solution to reducing the pressure to cut the hot dog is to provide two or more tiers of blades, it is simply improper to combine other references that would contradict that purpose or solution to the problem.

Furthermore, Gagliardi does not describe an embodiment having only one plurality of blades *extending across* the interior in a plane perpendicular to the inner and outer walls of the hollow body. Applicant would point out that Webster's Dictionary defines "across" as "from one side to the opposite side of". See Webster's New Collegiate Dictionary, Page 11, Copyright 1981, G. & C. Merriam Co. Accordingly, Gagliardi does not describe blades extending "across" the interior of the body.

For the same reasons indicated in the response to the 102(b) rejection (incorporated herein by reference), Gagliardi does not in and of itself describe or suggest all of the limitations of claims 1, 2, and 4. A prima facie case of obviousness is only supported when all of the limitations of the claims are described by the reference(s) supporting the rejection. Again, Gagliardi describes multiple tiers of blades, not a single plurality of blades laterally aligned at outer points as described and claimed in claims 1, 2, and 4.

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With regard to **Pesce** and **Priore**, Applicant is of the position that in the absence of **Gagliardi** (due to its disqualification as prior art for teaching away from the present invention), neither **Pesce** nor **Priore** would when taken alone or together satisfy the requirement that the body be "elongated" as per claim 1, or that the body have "a length greater than the cross-sectional area of the body" as per claim 2.

Applicant would point out that *Webster's Dictionary* defines "elongated" as "long in proportion to width". See *Webster's New Collegiate Dictionary*, Page 366, Copyright 1981, G. & C. Merriam Co. Neither **Pesce** nor **Priore** describe an "elongated" body as described in the specification and shown in the figures, or as described by Webster. Furthermore, **Priore** does not describe the cutting of an elongated flexible food product such as a hot dog, but rather a pie.

One looking to solve the problem of cutting a hot dog would not look to **Priore** because **Priore** is not concerned with cutting flexible meat products, but is instead concerned with cutting a pie or pastry. A pie or pastry is certainly not an elongated food product where the length is greater in dimension than the width. **Pesce** solves the problem of cutting a flexible food product by employing a cutting apparatus that does not involve an elongated body but instead utilizes a short body having a diameter greater than its width. There is nothing in **Pesce** to suggest changing the body to that shown in **Gagliardi**. Furthermore, feeding the hot dog through the cutter of **Pesce** in the manner described would not be possible if using an elongated body like that of **Gagliardi**. In sum, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Finally, as discussed in column 1, lines 38-40, **Pesce** states that it is an object of the invention to provide a cutter for hot dogs and the like which is of a simple and economical construction. Certainly, providing an elongated housing as claimed in the present invention is counterintuitive with regard to the design

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that Pesce describes. Accordingly, Pesce actually teaches away from providing a construction that is more complex and/or expensive than what he describes. It will be appreciated that the present elongated hollow body requires more raw material and is therefore more expensive and of greater complexity.

Applicant therefore takes the position that the Office has not stated a prima facie case of obviousness. In particular, the references when taken alone or together must with particularity state all of the limitations of the claims. As noted by the examiner, the blades 38 of '771 exist in at least two tiers and are therefore not laterally aligned. Nevertheless, the examiner indicates that it would have been obvious to one of ordinary skill in the art to remove one of the tiers of blades of '771. The examiner, however, has not pointed to the requisite motivation to do the same.

In fact, '771 indicates that two or more tiers reduce the cutting pressure against the food product thereby requiring less force to cut the hot dog. See column 3, line 53 through column 4, line 17 of '771, herein incorporated by reference. Accordingly, '771 teaches away from laterally aligning the blades 38, or stated another way, from eliminating one of the two tiers of blades 38. Elimination of one of the tiers would be counterintuitive to one of ordinary skill given the comments by Gagliardi. Furthermore, without a showing of a motivation, the examiner's argument is apparently a prohibited "obvious to try" rationale that without objective support is not supportive of a prima facie case of obviousness.

Accordingly, Applicant traverses the rejection of the claims under 35 U.S.C. 103(a) over Gagliardi in view of Pesce or Priore, for in view of the arguments presented, a prima facie case of obviousness has not been supported by any of the references taken alone or in combination. Further, when a reference teaches away from an invention, it cannot concurrently suggest the same.

c) Claims 6 and 7 are rejected under 35 U.S.C 103(a) as being unpatentable

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over Gagliardi, and further in view of Berler. As noted above in the 102(b) and 103(a) discussions of Gagliardi, incorporated herein by reference, Gagliardi does not describe a cutting device with a single plurality of blades whereby each blade has an outermost portion substantially laterally aligned with respective outermost portions of the remaining blades. The inherent advantages of such a device includes manufacturing simplification with reduced costs and reduced parts, while still providing a sliced product. With regard to claims 6 and 7, Berler does not resolve the deficiencies of Gagliardi as described above, for neither Berler nor Gagliardi when taken alone or combined describe a plurality of blades laterally aligned at outermost portions of the blades.

d) Claims 6 and 7 are rejected under 35 U.S.C 103(a) as being unpatentable over Gagliardi in view of Pesce or Priore, and further in view of Berler. Applicant directs the examiner's attention to the discussion of item b) relative to Gagliardi, Pesce and Priore, and incorporates the same discussion herein by reference. For the reasons stated above in item b), Applicant takes the position that neither Gagliardi, Pesce, nor Priore when taken alone or together would suggest or motivate one of ordinary skill in the art to provide a cutter as claimed in claims 6 and 7. The inherent advantages of such a device includes manufacturing simplification with reduced costs and reduced parts, while still providing a sliced product. With regard to claims 6 and 7, Berler does not resolve the deficiencies of Gagliardi, Pesce, or Priore as described above, for Berler does not describe a plurality of blades laterally aligned at outermost portions of the blades extending across a body interior in a plane perpendicular to the body. This design provides a device that effectively cuts the meat product while reducing the complexity of the cutting device.

In sum, in view of the reasons given above, there is no motivation found in either reference to combine one with the other. The requisite motivation to combine must be found within the references when asserting a prima facie case

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of obviousness. Further, when a reference teaches away from an invention, it cannot concurrently suggest the same.

e) Claims 1, 2, 4, 6, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pesce in view of Gagliardi or Aguerrevere et al. Applicants take the position that the examiner has not shown the requisite motivation to combine the references. Specifically, Pesce does not provide any suggestion or motivation to provide an elongated housing wherein the length is greater than the diameter. There must be some suggestion or motivation within the reference to show the requisite motivation to combine. The examiner has not with particularity stated the reason or motivation to combine. In essence, Pesce does not recognize the need to provide a support for the hotdog within the apparatus and therefore does not contemplate an elongated body for support of an elongated food body, in accordance with the present invention.

As discussed in column 1, lines 38-40, Pesce states that it is an object of the invention to provide a cutter for hot dogs and the like which is of a simple and economical construction. Certainly, providing an elongated housing as claimed in the present invention is counterintuitive with regard to the design that Pesce describes. Accordingly, Pesce actually teaches away from providing a construction that is more complex and/or expensive than what he describes. It will be appreciated that the present elongated hollow body requires more raw material and is therefore more expensive.

With regard to the combination of Gagliardi with Pesce, Applicant incorporates by reference the argument presented in item b) above. For the reasons given, Gagliardi would not alter the multiple-tier design of the blades in the cutting device described therein, for doing so would be counter to the problem solved by Gagliardi: that is simplifying the cutting of a meat product such as a hot dog. Furthermore, Gagliardi teaches movable blades, not fixed blades. As such, Gagliardi teaches away from claims 1, 2, 4, 6, 9, 10, 16, and 17.

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It should further be emphasized that counter to claims 9, 10, 16, and 17, the blades 14 of Pesce are not fixed to prevent movement and in fact rotate with collar 13. See column 3, lines 1-10, for example. There is nothing to suggest that the blades should be fixed to the housing as in the present invention. Note column 4, lines 23-27 of Pesce, for example, wherein rotation of the blades in the outer casing is assured by an inner edge 48. Accordingly, Pesce teaches away from fixed blades as affirmatively claimed in claims 9, 10, 16, and 17.

Aguerrevere does not resolve the deficiencies of Gagliardi or Pesce. For like Gagliardi, Aguerrevere indicates that two tiers of blades, 23 and 24, respectively, are included in the cutting device. There is no motivation or suggestion offered within the references themselves to change the design to a single tier of blades, as affirmatively claimed in the present invention.

f) Claims 6, 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pesce in view of Gagliardi or Aguerrevere, and in further view of Berler. Applicant takes the position that a prima facie case of obviousness with regard to claims 6 and 7 has not been shown. Regarding claims 6 and 7, Applicant again notes that neither Pesce nor Berler describe a hollow body having a length greater than its diameter (e.g. elongated). Nor, as explained above, is there any suggestion or motivation within Pesce to combine a reference that describes an elongated housing. The comments given above are equally applicable here and are incorporated by reference. In essence, none of the references describes an elongated housing, or a body having a length greater than the diameter. Accordingly, a prima facie case of obviousness has not been supported with regard to claims 6 and 7.

With regard to claims 13 and 14, Applicant takes the position that the current amendments define fixed blades that prevent movement of the blades. Pesce, Gagliardi, and Aguerrevere all describe blades that either rotate within a collar 13, or move along the body of the device. It will further be appreciated

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that again, with regard to the length being greater than the diameter, Pesce does not suggest or motivate one of ordinary skill in the art to change his housing to the elongated body of the present invention. There must be some motivation to combine the references within the references themselves to properly support a prima facie case of obviousness. Stated another way, there is no motivation or suggestion offered within the references themselves to change the design to a single fixed tier of blades, as affirmatively claimed in claims 13 and 14 of the present invention.

g) Claims 13 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Berler. Lin does not describe a cutting device having a plurality of blades extending across the interior (that is from one side to the other) and fixed within the interior of the body. If Lin did describe this, then the coring function described in column 3 of Lin would not be possible. Berler does not cure this deficiency of Lin and therefore a prima facie case of obviousness is not supported.

Finally, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, *and not based on applicant's disclosure*". In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It would appear that the examiner, with the benefit of the present application, exercised impermissible hindsight reconstruction, particularly in view of the art cited. For the particular combination of the elements of the present invention as claimed are not suggested or described in the references cited, for the references describe other cutting problems solved in other ways. None of the references cited by the examiner enable the present approach, nor do they recognize the present problem of supporting a flexible meat product to ensure a steady plurality of cuts throughout the meat product length if desired. As such, they cannot when taken alone or in combination

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with each other of present or suggest a solution to the same when viewed by one of ordinary skill in the art.

Further, "A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The examiner has not provided an objective reason to combine the references other than to suggest that all the references describe cutting devices and therefore all the features should be interchangeable. This would ignore the solutions to the various problems that each reference in and of itself solves in the cutting art.

In sum, none of the references when taken alone or when taken together suggest or describe the present invention. Stated another way, for the reasons given, a prima facie case of obviousness cannot be supported by references that teach away from the present invention, nor can it be supported without the requisite showing of a motivation to combine the references.

The examiner is advised that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) Utilizing the cutting device of Lin would change the cuts provided by the present invention and therefore the principle of operation of the device.

The examiner is further advised that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

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(9) Conclusion:

In sum, Applicant respectfully traverses the rejections given for the reasons stated.

Accordingly, the allowance of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17, and passage of the subject application to issue is courteously solicited.

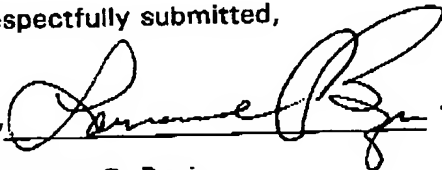
For the above-stated reasons, the examiner has simply not met the burden of substantiating a prima facie case of obviousness relative to claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17. Accordingly, reversal of the Examiner's rejection of claims 1, 2, 4, 6, 7, 9, 10, 13, 14, 16, and 17, and issuance of the present application is courteously solicited.

Applicants have calculated a fee of \$250.00 for the appeal brief in connection with this brief. Our credit card authorization sheet is enclosed authorizing the amount of \$250.00. The Commissioner is hereby authorized to charge any additional fees incident to the filing of this communication to Deposit Account No. 50-3238. A duplicate copy of the front page of this document is enclosed. Applicants have faxed three copies of this appeal brief pursuant to 37 C.F.R. 1.192.

Date 1/17/06

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(10) Appendix – Claims 1-17:

1. (pending and previously presented) A food utensil comprising:

an elongated hollow body for supporting an elongated food product, said elongated hollow body having an inner wall and an outer wall forming an interior, an open first end and a second end, a diameter, and a length greater than said diameter; and

a plurality of blades extending across said interior in a plane perpendicular to said inner and outer walls for cutting a food item, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.
2. (pending and previously presented) A food utensil comprising:

a hollow body having an inner wall and an outer wall forming an interior, an open first end and a second end, a cross-sectional area, and a length greater than said cross-sectional area; and

a plurality of blades extending across said interior in a plane perpendicular to said inner and outer walls for cutting a food item, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades.
3. (withdrawn) The utensil of claim 1 further comprising a plurality of grooves each longitudinally extending from the first end to a corresponding

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plurality of points approaching the second end and a blade rack slidably engaged with said outer wall for attachment of said plurality of blades wherein each of said plurality of blades correspondingly extends through one of said plurality of grooves.

4. (pending and previously presented) The utensil of claim 1 further comprising a base fixed to the second end.
5. (withdrawn) The utensil of claim 2 wherein said plurality of blades comprises a plurality of wires wrapped about said blade rack.
6. (original) The utensil of claim 1 further comprising a food receptacle removably attached to said first open end for holding a food product.
7. (original) The utensil of claim 6 further comprising at least one hole extending through said food receptacle and at least one corresponding prong extending through said at least one hole for holding said food product.
8. (withdrawn) The utensil of claim 2 wherein each of said plurality of grooves with respect to another equidistantly terminates between said first and second ends.
9. (pending and previously presented) The utensil of claim 1 wherein said plurality of blades is fixed to said inner wall thereby preventing movement of said plurality of blades.
10. (pending and previously presented) The utensil of claim 1 wherein said plurality of blades is fixed to said open first end thereby preventing movement of said plurality of blades.
11. (withdrawn) A food utensil comprising:

an elongated hollow body for encasing an elongated food product, said elongated hollow body having an inner wall forming an interior and an outer wall, an open first end and a closed second end, a

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diameter, a length greater than said diameter, and, a plurality of grooves each longitudinally extending from the first end to a corresponding plurality of points approaching the second end;

a plurality of blades extending across said interior, whereby said plurality of blades is the only plurality of blades of said food utensil, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and

a blade rack slidably engaged with said outer wall for attachment of said plurality of blades wherein each of said plurality of blades correspondingly extends through one of said plurality of grooves.

12. (withdrawn) The utensil of claim 11 wherein each of said plurality of grooves with respect to another equidistantly terminates between said first and second ends.

13. (pending and previously presented) An appliance comprising:

an elongated hollow body for supporting an elongated food product, said elongated hollow body having an inner wall and an outer wall forming an interior, a diameter, and a length greater than said diameter;

a plurality of blades fixed within said interior and extending across said interior thereby preventing movement of said plurality of blades; and

a receptacle for holding an item to be sliced, that upon appliance operation is slidably engaged along said outer wall thereby forcing said item against said blades for slicing thereof.

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14. (pending and previously presented) A method of slicing a food item comprising:
- providing a fixed plurality of blades within an elongated hollow body and across a diameter thereof thereby preventing movement of said plurality of blades, the elongated hollow body having a length greater than the diameter;
 - inserting an elongated food item to be sliced in a receptacle, said elongated food item supported by said elongated hollow body; and
 - slidably engaging the receptacle along an outer circumference of the hollow body to bias the item against and at least partially through the blades thereby slicing the item.
15. (withdrawn) A method of slicing a food item comprising:
- placing an elongated food item within an elongated hollow body of an appliance along a length of the hollow body, said elongated food item supported by said elongated hollow body, the elongated body having a length greater than a respective diameter;
 - providing a plurality of blades within the hollow body and across the diameter thereof, whereby said plurality of blades is the only plurality of blades of said appliance, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
 - sliding the blades along the length of the hollow body thereby slicing at least a portion of the cylindrical food item.
16. (previously presented) A method of slicing an elongated food item comprising:
- providing a plurality of fixed blades within an elongated hollow body and across a cross-section thereof thereby preventing movement of the blades, the elongated body having a length greater than the

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diameter, whereby said plurality of blades is the only plurality of blades of said elongated food body, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
affecting a relative motion between the elongated food item and the plurality of blades thereby slicing at least a portion of the food item and yet supporting the elongated food item within the elongated hollow body.

17. (previously presented) A food slicer comprising:
an elongated hollow body for slicing an elongated food item, said elongated hollow body having an inner wall and an outer wall, said walls defining an elongated interior that supports the elongated food item, and said hollow body having a length greater than a respective diameter;
a plurality of blades fixed within said elongated hollow body and extending across a cross-section thereof thereby preventing movement of said blades, whereby said plurality of blades is the only plurality of blades of said food slicer, and each of said plurality of blades is substantially laterally aligned at an outermost portion thereof with a respective outermost portion of each of the remaining plurality of blades; and
a means for affecting a relative motion between said plurality of blades and the elongated food item whereby at least a portion of the elongated food item is sliced within said interior.